REMARKS/ARGUMENTS

Entry of the current amendment and allowance as currently amended is respectfully requested. Independent claims 1, 17 and 24 have been amended to further clarify the invention.

Claims 1 and 17 are amended to clarify that applicant's invention transfers multiple records of individual customers from an existing database to the web-based database and does not generally seek to process individual customer data records in an existing database domain, thereby preventing unauthorized modification or corruption of the existing database. The movement of the maintenance of the customer database information also frees the owner of the existing database from the responsibility of address modification and update. If the customer does not wish to have their records maintained, they may simply ignore the request providing them with their specific unique access account code and their information will not be updated. Claim 17 is also amended to clarify that the invention functions with multiple customer data records and further generates unique access accounts for each of the multiple customer data records. In addition, claim 17 is amended to clarify that Applicants' system enables modification of the customer data records.

Claims 24-28 were previously presented to further claim the invention. Independent claim 24 is directed towards a method for customers to update their

contact information without registering with the system. Since the customer is an accessing his record on the web-based database and not on the internal existing database, no chance for data corruption of the existing database exists. Claim 24 has been further amended to claim the feature of automatic updating based upon additional information provided upon access by the customer. Claim 25 is directed toward specific types of customer information. Claim 26 is directed towards modification of the customer record via a telephone number. Claim 27 is directed towards the modification being a correction.

The attached amendments do not add new matter and are for clarification of the web-based database creation and maintenance process only. Support for the amendments can be found, inter alia, at paragraphs 24, 27, 38 and 42. Applicants believe the foregoing amendments place the application in condition for allowance. Applicants therefore respectfully requests further examination and allowance of the existing claims.

Refusal to Enter Applicant's Previously Filed Rule 132 Declaration is Erroneous

Applicants previously filed a declaration under Rule 132 because the Examiner found the declaration (without discussing the substance of the factual statements contained therein) "insufficient" because of a) timeliness, b) not having sufficient explanation why it wasn't submitted earlier, c) not being detailed as to

include order sales invoices, or d) offering an explanation of where or when the sales were made, when and where the systems were first installed, failed to disclose the number of orders fulfilled and other specific accounting detail.

Clearly, the filing of the declaration together with the filing of the Request for Continued Examination makes the filing timely. See MPEP 716.01(A)(4). The declaration was timely for consideration by the Examiner in this RCE proceeding.

The Declaration of Tom Ren, one of the inventors, discloses the dates of first commercial use, a list of customers, the advertising spent on these products and its general acceptance in the trade or business for its intended use. A causal nexus between the claims of the pending application and the success is established and the Examiner wrongfully refused to consider this evidence of the useful and unique features of the invention claimed by Applicants. All of the other criteria used by the Examiner to refuse consideration of the Rule 132 Declaration are unwarranted.

Although Applicants dispute the Examiner has raised a prima facie case of obviousness in the present Office Action (*In re Rijckaert*, 28 USPQ2d (Fed. Cir. 1993)), the Rule 132 declaration, together with the explanation offered herein, clearly would provide some evidence to rebut any such obviousness rejection.

Moreover, appropos of the Examiner's timeliness argument by way of explanation, Applicants did not believe any Rule 132 would be required after the

first Office Interview because they candidly believed the language for allowable

claims had been worked out between the Applicants' attorneys and the Examiner.

Rejections Under 35 USC §103(a) Including A Confusing Reference to "Robertson"

The rejections in the February 24, 2006, Office Action ("OA") were all

obviousness-related based on: U.S. Patent 6182131 to Dean et al. (*"Dean"*) in view

of U.S. Patent 6175831 to Weinreich (*"Weinreich"*)(as to claims 1-4, 6-7, 9, 11, 12,

17, 21, 24-24, 27-28); Dean in view of Weinreich and further in view of U.S. Patent

6925477 to Champagne (*"Champagne"*)(as to claim 5); Dean in view of Weinreich

and further in view of U.S. Patent 6625258 to Ram et al. (*"Ram"*) and perhaps to

another reference to *Robertson* assumed for the purposes of this response—although

not specifically described by the Examiner by serial number out of the 3,681 patents

issued to a "Robertson"—to be the same Robertson (U.S. Patent 6269369) previously

relied upon in prior office actions(as to claims 8, 10, 20, 22-23 and 26); and *Dean* in

view of *Weinreich* and further in view of U.S. Patent 6108691 to Lee (*"Lee"*)(as to

claim 19).

The Examiner in discussion of claim 8 makes another reference to a

Robertson. Again, it is unclear to Applicant if this is a remnant from a prior office

action in which the Examiner previously relied upon *Robertson* now mistakenly

incorporated in error into the present Office Action, or if the Examiner truly meant to

refer to *Robertson*. See, for example, Office Action mailed 10/24/05, pages 15-19 (incorporating references to a *Robertson* reference without formal identification of the reference); Office Action mailed 7/12/05, pages 2-13 (actually relying upon a reference to US Pat. No. 6,262,369) to *Robertson*. Out of an abundance of caution to properly traverse all of the Examiner's grounds for rejection--which is the intent of Applicant--Applicant will address, to the extent understood, the references to *Robertson* in the remarks.

35 U.S.C. § 103 Rejections

The February 24, 2006 Office Action ("office action" or "OA") rejects claims 1-4, 6,7, 9, 11, 12, 17, 21, 24, 25, 27 and 28 and 26-31 under 35 U.S.C. §103(a) as being unpatentable over *Dean* in view of *Weinreich*; claim 5 over *Dean* in view of *Weinreich* and in further view of *Champagne;* claims 8, 10, 20, 22, 23 and 26 *Dean* in view of *Weinreich* and in further view of *Ram* (although in discussion of claim 8, the examiner also refers to a *Robertson)*; and, finally, claim 19 *Dean* in view of *Weinreich,* and further in view of *Lee.*

A prima facie case of obviousness can only be established when the examiner establishes three basic criteria: a) suggestion or motivation in either the references cited or in the knowledge generally available to a person having ordinary skill in the art, to modify the reference or combine the references; b) reasonable expectation of success in so doing; and c) the prior art references must teach or suggest all the claim

limitations. *In re Jones,* 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Merck & Co.,* 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986); *In re Royka,* 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The burden on the Examiner is described as requiring "…rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *In re Dembiczak,* 175 F.3d 994, 50 USPQ 2d 1614 (Fed. Cir. 1999). For the reasons set forth herein, applicant respectfully will show none of the claimed prior art references relied upon, either alone or in combination, suggest or provide motivation for combining the references in the manner suggested by the examiner. None of the claimed prior art provides a reasonable expectation of success in achieving the alleged suggested combination, nor do the claimed prior art references teach or suggest all the claim limitations as described in the amended claims provided above. Picking and choosing features from a number of prior art references does not teach or suggest that such features can or should be combined. *Ex Part Clapp,* 227 U.S.P.Q. 972 (Bd. Pat. App. and Inter. 1985).

The Examiner misapprehends the standards imposed by the statute and regulations upon the examiner to first review the language of the claim as a whole. MPEP 2141.02. For example, at page 4, the Examiner states: "Clearly, the applied references, Dean and Weinreich are all concerned to creating user profiles (sic).

Thus, these references are analogous and within the same aspects of endeavor and are combinable." The examiner subsequently argues that it would have been obvious "to a person of an ordinary skill in the art at the time the invention was made to apply Weinreich's teaching of sending a password to a user and using password to log on the system for updating user profile in database 70 to Dean's system in order to notify users to access their new accounts and further allow users directly update their accounts in a web database any time via Internet quickly without take many hours to change their accounts." *Dean* is not concerned with creating user profiles, but rather in the wholesale transfer of existing user names (and passwords) to a new database domain to allow sign-on by the users of the originating database on the new database. The transferred sign-on information is isomorphic in the second database with the information contained in the first originating database. There is no creation of a unique customer number (account access code) performed in the *Dean* reference.

The reliance upon an automatic creation of accounts in the second database from information received from the originating database again suggests the Examiner failed to appreciate the appropriate legal standard for an obviousness rejection. Having reduced Applicant's invention to the gist of "creating user profiles", the Examiner completely ignores the problems sought to be solved and the unique and successful manner of solving these problems offered by Applicant's invention. Furthermore, the Examiner compounded her error by refusing to consider the

declaration of commercial success utilizing strained and unwarranted legal standards for which no support can be found. The specific rebuttal to such arguments will be offered <u>infra</u>.

Non-analogous Art Does Not Support an Obviousness Rejection

The combination of *Dean* and *Weinreich* are not in analogous art fields. Class 709, the only class searched in *Dean*, suggests searching in classes 228, 340, 710, 713 and 717, while *Weinreich* provided a search in classes 707, 345, 364, 370, 706, 345, 358, 440, 444, 705, 434 and 364. The differences in the problem sought to be solved by Applicant's invention, not addressed in either *Dean* or *Weinreich*, together with the absence of cross-referencing in the Manual of Classification, suggests that the art is non-analogous and may not be used to find obviousness of the present application. See MPEP 2141.01(a).

Summary of Prior Art Relied Upon for the 35 U.S.C. § 103(a) Rejections

None of the prior art relied upon by the Examiner addresses the problem sought to be solved by Applicants. None of the prior art cited suggests or offers any motivation to combine and the Examiner does not rely upon knowledge generally available, to modify the reference or to combine reference teachings.

Dean, the primary reference relied upon, is a patent for automatically populating a second network or domain by polling an existing network or domain for a plurality of existing user names, which are then passed to a second network

account manager program which creates an account in the second network for each of the plurality of user names exactly as they are shown in the originating database. This automatic population saves the original plurality of users from the need to individually sign into the second network to set up their own user name on the second network. Col. 1, lines 36-43. The automatic population feature is intended to save each user from having to sign onto a new database and establish an account using their sign-on and password. The system did not intend to create or teach creating a unique new account access code and password and forwarding that password to parties outside of the organization so that they could sign-on to the database to correct information relied upon by the creating entity to contact them. *Dean's* signon (and password, if passed) will be the same in both the originating database and the new database. If *Dean* created a unique signon, known only to the outside customer, the whole purpose of *Dean*'s automatic creation of identical accounts in a second database domain would have been frustrated.

    Weinreich is a patent for creating, updating and maintaining a single networked database wherein each user of the database may create relationship fields to allow linking to other users having similar relationship fields in their respective records. This permits searching or organizing the database by relationships rather than individual account identifiers. See generally Cols. 3 and 4. Each user must become (ie. register) by their separate registrations in the database

to become a "member." See the description of the BAM routine of the DSP 12. Col. 7, lines 4-23. Each "user" is pre-registered in the system before the linking takes place. *Weinreich* does not broadcast a password signon to individuals outside of those who initialized their own account within the system.

Champagne is a patent for a system which automatically populates a second database from records in first database irrespective of the correspondence between the fields of each database using a field mapping process which directs a data transfer protocol to establish the link between the first and the second databases.

Ram is a patent for a communication management system which coordinates telephone and data services through a virtual [communications] assistant system, VAS, which allows subscriber access to phone messages from e-mail access portals, listening or sending e-mails from a telephone, forwarding of e-mails to a fax machine, through a single number access for each subscriber/user. Col. 3, lines 33-51.

Robertson is a patent for coordinating a personal contact manager database on a client with a single relational database on a networked server, thereby allowing the individual to allow access on an individual basis certain data concerning the granting user to the browsing user. See Abstract.

The Examiner engaged in inappropriate "picking and choosing" of separate features from each of these patents to argue that the Applicant's invention would

have been obvious to one having ordinary skill in the art, without the slightest hint of analyzing how the separate prior art patents suggested or taught the combination. The fact that references can be combined or modified is not sufficient to establish a prima facie obviousness rejection. The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. The proposed modification of *Dean*, the primary reference, to create unique account numbers would render *Dean* unsatisfactory for its intended purpose because the originating user would not be able to sign into the newly opened database domain.

A further detailed analysis of the Examiner's erroneous analysis demonstrates the compounding of these errors in the Examiner's rejection of all claims pending.

Dean in view of *Weinreich* to reject claims 1-4, 6, 7, 9, 11-12, 17, 21, 24-25, 27-28

Claim 1 is rejected under 35 USC §103 because of *Dean* in view of *Weinreich*. The Examiner argues that *Dean* teaches automatic creation of user accounts in an external network so that users may access that external network, ie. users within the owner's network are automatically signed into the remote network. This is not the same as customer records being used to create a database in a web-based database to allow the customer to update the individual customer

records within that database for later selective access by the owner of the originating existing database. The *Dean* disclosure does not foresee the customer accessing its record and correcting the information contained in the database. Most importantly, *Dean* assumes the integrity of the information transmitted to the newly opened network database domain, while Applicant's invention intends for the individual customer to access and correct any misinformation contained within the database. As the Examiner cogently admits: "[t]he account manager of the ISP is not maintained and updated. The account manager of the ISP is a storage and not a web-based database." Office Action, pp. 6-7. Applicant's and *Dean's* system are significantly different.

The account registry, which is copied in *Dean*, is part and parcel of the operating system and creates a gateway into the initiating database for a browsing party. To allow a stranger, to have access to this information would completely compromise the original database system as well as the operating system upon which it resides. Clearly, *Dean* cannot be readily combined with any of the other cited prior art references to support an obviousness rejection, and no system manager would allow such a wholesale access to his operating system records.

Claim 17, the second independent claim the Examiner deems obvious because of *Dean* in view of *Weinreich* is likewise rejected because the Examiner picked and chose elements from prior art which was claimed to be the same as that

disclosed and claimed. The Auto-Populator feature of the claimed invention clearly takes database information and establishes a new web-based database with fields populated from the owner's database. This new web-based database then assigns new account identification to the customer accounts transferred and automatically broadcasts a message to the customer with a sign-on and password to allow the customer to sign on and update its records on the system. This is entirely different than the topology of the *Dean* disclosure where the original users are being automatically signed into a newly opened database system so that the multiple users in the first database would not be required to sign onto the system and create a new account one by one. No outsider will ever be allowed to access the newly created database of *Dean* since it is only to be accessed by the existing identified users. As previously noted, the account registry 30 from the LAN 10 is part of the operating system of the originating database and is generally only accessible to operating system personnel having sufficient privileges to allow access to this senstive information. See Col. 2, line 65- Col. 3, line 7. As such, it contains the vital information necessary to give priority and privileges to requests made by the user. This information is not generally made available beyond the confines of the original operating system registry. This information is never made available to other users. *Dean* is not analogous to the creation and use of a second database for contacting customers.

Applicants' web-based database claimed in claim 17 is wholly unlike *Dean*'s newly-opened database domain and cannot be combined with the single database system of *Weinreich* to make claim 17 obvious. The ability to sign onto the *Weinreich* database (for those who have previously become members and obtained their own passwords through the BAM routine previously discussed, and who have previously sought to create relationship fields within their own record to link with other users, is certainly not analogous to allowing a single user accessing their account to correct cutomer information errors while at the same time permitting rapid communication to all database-listed customers. The Examiner jumped from using a password to sign into the system to the conclusion that Weinreich taught the creation and sending of a password to a user new to the system. Accordingly, the Examiner again wholly failed to establish a prima facie obviousness rejection by use of the *Dean* and *Weinreich* prior art references.

Similarly, Applicants' third independent claim 24 describes a method of automatically populating, maintaining and updating a web-based database created from customer records obtained from an existing database. Applicants' comments relating to claims 1 and 17 are incoporated herein by reference. As previously noted, although the Examiner concedes the account manager of the ISP is "a storage and not is a web-based database…." (Office Action at page 15), Applicants are specifically claiming web-based database. No indication exists that *Dean*

creates new unique temporary access accounts for each of the multiple customers, nor checks those temporary access accounts for duplications and validity, nor broadcasts those temporary access accounts to the customer, previously unregistered with instructions to use the temporary account to sign into the web-based database to update their own records, thus relieving the originating operating system from the burden and security issues of having third parties access an internal database (the "originating database" of the disclosure).

***Dean* in view of *Weinreich* and further in view of *Champagne* to reject claim 5**

Although claim 5 is dependent from claim 1, the Examiner further cites *Champagne* as making claim 5 obvious because automatic mapping was done prior to Applicant's filing. As acknowledged in Applicants' disclosure, "mapping of database fields is well known in the art, and one of ordinary skill in the art will recognize the numerous ways of accomplishing such mapping." Para. 24. The Examiner's reliance upon *Champagne* in combination with *Dean* and *Weinreich* is again picking and choosing features and refusing to recognize the claimed invention "as a whole." It is not automatic mapping that's patentable, but rather the entirety of Applicants' claimed invention that's unobvious and therefore patentable. No explanation of the prior art is offered in the context of the invention claimed as a whole and therefore the Examiner has wholly failed to discharge the burden of establishing a prima facie obviousness rejection.

Dean in view of *Weinreich* and further in view of *Ram* (and perhaps *Robertson*) to reject claims 8, 10, 20, 22, 23 and 26

Ram (and perhaps *Robertson*) are combined with *Dean* in view of *Weinreich* to support the Examiner's rejection of claims 8, 10, 20, 22, 23 and 26. While it is not entirely clear how each of the cited references are combined because the Examiner wholly fails to specify the teaching in each which leads to the conclusion they are combinable, it appears that the function of telephone, pager, or fax communication is the intended manner of commuication sought to be made obvious. The combination of these forms of communication with the disclosures of *Dean* and *Weinreich* is really not explained by the Examiner. Again, the communication feature is picked from the cited prior art reference and offered as proof of the obviousness of the claimed combination claimed in Applicants' disclosure. No explanation of how the references teach or suggest the combination is offered and thus the Examiner has failed to carry her burden of establishing a prima facie obviousness claim in the present case. *Robertson* does not suggest or teach allowing browsing by telephone or fax, nor does it teach notification by automatically generated telephone or fax communication to the proposed browsing party. Consequently, the Examiner has failed to establish even a prima facie case of obviousness with the cited prior art references.

Dean **in view of** *Weinreich* **and further in view of** *Lee* **to reject claim 19**

The examiner picks and chooses *Lee* in combination with *Dean* and *Weinreich* to attempt an obviousness rejection of claim 19. *Lee* teaches providing a method of receiving e-mail messages without disclosing the e-mail address of the recipient so the user will not be bothered with excessive junk e-mail blasts. The Exmainer uses *Lee* to support an obviousness rejection by supposing Applicants' invention related to the sending of mutiple database records to different vendors. While, again, it is not entirely clear how this cited prior art relates to the rejected claim 19, Applicants assert the Examiner was again engaging in impermissible picking and choosing of features to establish obviousness without consideration of the claimed invention as a whole.

Dependent Claims Should be Allowed if the Independent Claim is Allowed

Claims 2-4, 6, 7, 9, 11, 12 all depend from claim 1 and would be allowable if claim 1 is allowable. Claims 19-24 all depend from claim 17 and would be allowable if claim 17 is allowable. Claims 25-28 all depend from claim 24 and would be allowable if claim 24 is allowable. See MPEP 2143.03; *In re Fine,* 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Conclusion

During the course of these remarks, Applicant has at times referred to particular limitations of the claims that are not shown in the applied prior art. This

shorthand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention.

If the Examiner has any questions or comments regarding this communication, she is invited to contact the undersigned directly to expedite the resolution of this application. Entry of this Amendment and allowance of the amended claims is respectfully requested.

Respectfully submitted,

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